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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/228,103      | 01/11/1999  | HARSH GOPAL          | TPP:628US           | 7307             |

7590 03/21/2002  
DUNN & ASSOCIATES  
PO BOX 96  
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EXAMINER

HON, SOW FUN

ART UNIT PAPER NUMBER

1772

DATE MAILED: 03/21/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

1 hr 2:21 PM  
DALLIES  
(214) 965-7364  
R# 46733

**Advisory Action**

Application No.

09/228,103

Applicant(s)

GOPAL, HARSH

Examiner

Sow-Fun Hon

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 February 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment to advisory action.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 16-20.

Claim(s) objected to: None.

Claim(s) rejected: 2-10,12,14 and 15.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: Attachment to advisory action

sh

*Advisory Action*

1. The newly proposed amendment has not been entered since it changes the scope of newly independent claim 2, which changes the scope of the other claims dependent on it. Therefore, the newly proposed amendment raises new issues.

2. In addition, the newly proposed amendment does not place the application in better form for allowance. Applicant is apprised of *prior art* which has not been discussed in prior actions. Applicant's arguments are addressed below in order to advance prosecution.

3. Applicant argues that the coating of Rose contains a much higher percentage of oil than what could be present in Applicant's invention. Applicant is respectfully reminded that the term "comprising" in the present claims does not preclude the amounts of oil that are present in the coating of Rose.

4. Applicant directs attention to the discussion on the differences between paint coatings from emulsions and paint coatings from solutions, so as to demonstrate that there is a definite difference between the coating of Rose and that of Applicant's. Applicant is respectfully reminded that Rose discloses that the polyglycerol ester is poorly soluble in the oil ('920, column 4, lines 1-15), and thus requires a co-solvent of acetylated fatty monoglyceride ('920, column 3, lines 60-75). It is therefore unclear whether a stable homogeneous emulsion is formed, or whether a true binary solution is achieved for the coating solution of Rose. In any event, the materials of paints and the materials of food casing lubricants are very different so that a direct inference from the comparison of the dried paint coatings with respect to the properties of the dried food coatings is not possible, especially since the polyglycerol esters described in Applicant's claims are viscous liquids, not solids as the dried paints are.

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5. Applicant argues that the combination of Bridgeford and Colliopoulos et al. fails to suggest improvement in food casing peeling performance. Applicant is respectfully reminded that Bridgeford, the primary reference, does expressly address the improvement of the peelability of sausage casings with the coatings ('981, column 1, lines 45-50). Colliopoulos et al. is the secondary reference which compensates for the failure of Bridgeford to teach polyglycerol esters (polyglycerides) as a surfactant (emulsifying agent) in place of monoglycerides in a glycerol-water solution ('981, column 55-65). Colliopoulos et al. teaches that the claimed specific polyglycerol esters are emulsifying agents which provide water/oil emulsions physically stable for one year ('632, column 1, lines 1-50), thus providing the motivation to combine with the primary reference. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Any inquiry concerning this communication should be directed to Sow-Fun Hon whose telephone number is (703)308-3265. The examiner can normally be reached Monday to Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (703)308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

SH 03/18/02

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

3/19/02